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| 09/775,568 | 02/05/2001 | Takefumi Wakabayashi | P20549 | 6692 |
| 7055 | 7590 | 08/13/2004 | EXAMINER | |
| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | LETT, THOMAS J | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2626 | DATE MAILED: 08/13/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,568

Applicant(s)

WAKABAYASHI, TAKEFUMI

Examiner

Thomas J. Lett

Art Unit

2626

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 February 2001.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1,2,4-11 and 13-18 is/are rejected.
7) Claim(s) 3, and 12 is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
10) The drawing(s) filed on 05 February 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4,5,6.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because (1) the second term "IS" of ST901 of Fig. 9 should be removed, and (2) the term "FUNCTUION" should be corrected to read "FUNCTION" in ST913 of Fig. 10. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: the term "sever" should be replaced with the term "server" (p2, line 23).

Appropriate correction is required.

3. The disclosure is objected to because of the following informalities: the term "determines" should be replaced with the term "determine" (p14, line 13).

Appropriate correction is required.

4. The disclosure is objected to because of the following informalities: the term "IAFX" should be replaced with the term "IFAX" (p15, line 26).

Appropriate correction is required.

Claim Objections

5. Claim 2 is objected to because of the following informalities: the phrase "said receiver" should be changed to read "said mail receiver" (p34, line 26). Appropriate correction is required.

6. Claim 4 is objected to because of the following informalities: the term "no" should be removed from the claim (p35, line 19). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 2 states "and then said receiver receives an error mail" (p34, lines 26-27), but the specification indicates that a mail receiver receives an error mail. A "said receiver" is mentioned again within the claim (p3, lines 1-2) and cannot be the same receiver.

8. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 4 states "and then said receiver receives no a DSN from said receiver" (p35, lines 19-20), but the specification indicates that a mail receiver receives a DSN from a receiver. A "said receiver" should be changed to read "said mail receiver" (p35, line 19). "Said receiver" is mentioned again twice within the claim (p35, line 20 and lines 22-23) and these references seem to be of a receiver on the destination side of the communication.

9. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 11 states "and then said receiver receives an error mail" (p38, lines 9-10), but the specification indicates that a mail receiver (on the transmitting side) receives an error mail from a receiver.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Otsuka et al (US Patent 6,700,674 B1). With respect to claim 1, Otsuka et al disclose a facsimile system 10 (see Fig. 2), that contains a facsimile apparatus 1 with an internet facsimile transmission means that executes a facsimile transmission via the internet when an e-mail address is designated (col 2, lines 57-59), which reads on mail transmitter transmits image information on a computer network in accordance with an e-mail transfer protocol;

and an automatic re-transmitting means which, when it is determined by the automatic confirming means that, even though a specified time has elapsed, a delivery notice has not arrived, performs re-transmission of the image information by the transmitting means (col 4, lines 16-22), which reads on facsimile transmitter transmits said image information in accordance with a facsimile communication protocol, wherein when said mail transmitter transmits said image information to a receiver and then said receiver normally receives no corresponding image information within a predetermined

time period, said facsimile transmitter retransmits said image information to the same person as said receiver.

Claim 10 is a method claim, and is rejected for the same reasoning as that of claim 1.

11. Claims 2 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Otsuka et al (US Patent 6,700,674 B1). With respect to claim 2, Otsuka et al disclose a facsimile system 10 (see Fig. 2), that contains a facsimile apparatus 1 with an internet facsimile transmission means that executes a facsimile transmission via the internet when an e-mail address is designated (col 2, lines 57-59), which reads on mail transmitter transmits image information on a computer network in accordance with an e-mail transfer protocol;

when performing a facsimile transmission via the internet, when facsimile information, that has been converted to electronic mail, does not arrive at the receiver for some reason, a non-delivery notification is returned as electronic mail (col 1, lines 62-66), which reads on mail receiver receives an e-mail message on said computer network in accordance with the e-mail transfer protocol; and

an automatic re-transmitting means which, when it is determined by the automatic confirming means that a non-delivery notice has arrived at the server, performs re-transmission of the image information by the transmitting means (col 4, lines 16-22), which reads on a facsimile transmitter transmits said image information in accordance with a facsimile communication protocol, wherein when said mail transmitter transmits said image information to a receiver and then said receiver

receives an error mail, said facsimile transmitter retransmits said image information to the same person as said receiver.

Claim 11 is a method claim, and is rejected for the same reasoning as that of claim 2.

12. Claims 4,6,13, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Otsuka et al (US Patent 6,700,674 B1). With respect to claim 4, Otsuka et al disclose a facsimile system 10 (see Fig. 2), that contains a facsimile apparatus 1 with an internet facsimile transmission means that executes a facsimile transmission via the internet when an e-mail address is designated (col 2, lines 57-59), which reads on mail transmitter transmits image information on a computer network in accordance with an e-mail transfer protocol;

when performing a facsimile transmission via the internet, when facsimile information, that has been converted to electronic mail, does not arrive at the receiver for some reason, a non-delivery notification is returned as electronic mail (col 1, lines 62-66), which reads on mail receiver receives an e-mail message on said computer network in accordance with the e-mail transfer protocol; and

an automatic re-transmitting means which, when it is determined by the automatic confirming means that a non-delivery notice has arrived at the server, performs re-transmission of the image information by the transmitting means (col 4, lines 16-22), which reads on a facsimile transmitter transmits said image information in accordance with a facsimile communication protocol, when said mail transmitter transmits said image information to a receiver and then said receiver

receives no a DSN from said receiver within a predetermined time period, said facsimile transmitter retransmits said image information to the same person as said receiver.

Claim 13 is a method claim, and is rejected for the same reasoning as that of claim 4.

With respect to claim 6, Otsuka et al disclose an automatic re-transmitting means which, when it is determined by the automatic confirming means that a non-delivery notice has arrived at the server, performs re-transmission of the image information by the transmitting means (col 4, lines 16-22), which reads on a facsimile transmitter transmits said image information in accordance with a facsimile communication protocol, when said mail transmitter transmits said image information to a receiver and then said receiver receives no a DSN from said receiver within a predetermined time period, said facsimile transmitter retransmits said image information to the same person as said receiver.

Claim 15 is a method claim, and is rejected for the same reasoning as that of claim 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al (US Patent 6,700,674 B1) in view of Terao (US Patent 6,389,121 B1).

With respect to claim 5, Otsuka et al does not disclose that transmission data stored in a memory is erased. Terao discloses the NFAX 100 is configured to transfer the received facsimile image information to the SV 104 by E-mail when determining that the printer 6 is in an inoperative condition, and to erase the received facsimile image information from the image memory 9 upon completing the transmission to the SV 104 (col 12, lines 16-22). Otsuka et al and Terao are analogous art because they are from the similar problem solving area of storing data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Terao to Otsuka et al in order to obtain a memory saving operation. The motivation for doing so would be to optimize the use of a memory space.

Claim 14 is a method claim, and is rejected for the same reasoning as that of claim 5.

14. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al (US Patent 6,700,674 B1) in view of Terao (US Patent 6,389,121 B1).

With respect to claim 7, Otsuka et al does not disclose a memory for storing image information transmitted by said mail transmitter, wherein said image information is erased from said memory after a lapse of a predetermined time period after said mail transmitter transmits said image information to the receiver. Terao discloses the NFAX 100 is configured to transfer the received facsimile image information to the SV 104 by E-mail when determining that the printer 6 is in an inoperative condition, and to erase

the received facsimile image information from the image memory 9 upon completing the transmission to the SV 104 (col 12, lines 16-22). Otsuka et al and Terao are analogous art because they are from the similar problem solving area of storing data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Terao to Otsuka et al in order to obtain a memory saving operation. The motivation for doing so would be to optimize the use of a memory space.

Claim 16 is a method claim, and is rejected for the same reasoning as that of claim 7.

15. Claims 8 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Otsuka et al (US Patent 6,700,674 B1) in view of Terao et al (US Patent 6,389,121 B1). With respect to claim 8, Otsuka et al disclose a facsimile system 10 (see Fig. 2), that contains a facsimile apparatus 1 with an internet facsimile transmission means that executes a facsimile transmission via the internet when an e-mail address is designated (col 2, lines 57-59), which reads on mail transmitter transmits image information on a computer network in accordance with an e-mail transfer protocol;

and image data is stored in RAM 13, and the data is converted the data into an image file of the tag image file format (TIFF) prior to transmission (col 19, lines 11-13), which reads on a memory for storing said image information transmitted by said mail transmitter.

Otsuka et al does not disclose that a facsimile transmitter transmits said image information in accordance with a facsimile communication protocol, wherein said image information is erased from said memory after a lapse of a predetermined time period

after said mail transmitter transmits said image information to the receiver. Terao discloses the NFAX 100 is configured to transfer the received facsimile image information to the SV 104 by E-mail when determining that the printer 6 is in an inoperative condition, and to erase the received facsimile image information from the image memory 9 upon completing the transmission to the SV 104 (col 12, lines 16-22). Otsuka et al and Terao are analogous art because they are from the similar problem solving area of storing data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Terao to Otsuka et al in order to obtain a memory saving operation. The motivation for doing so would be to optimize the use of a memory space.

Claim 17 is a method claim, and is rejected for the same reasoning as that of claim 8.

16. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al (US Patent 6,700,674 B1) in view of Saito et al (US Patent 6,618,749 B1).

Otsuka et al does not disclose a memory for storing a receiver information table, which holds a mail address of the receiver and identification information, indicative of the presence or absence of a delivery confirmation mail transmission function in a receiver terminal apparatus, to be associated with each other, wherein when said mail receiver receives a delivery confirmation mail from the receiver, said identification information corresponding to the corresponding receiver is set to indicate the presence of the delivery confirmation mail transmission function. Saito et al discloses that a delivery status notification message table 39 stores a message regarding the

success/failure of delivery contained in the E-mail notifying the success/failure of delivery transmitted by the IFAX on the receiving side. This message is used for recognition by delivery status notification mail recognition section 32 (col 4, lines 51-58). Otsuka et al and Saito et al are analogous art because they are from the similar problem solving area of storing delivery information. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the memory feature of Saito et al to the transmission apparatus of Otsuka et al in order to obtain a memory to save delivery information. The motivation for doing so would be to record the status information of messages.

Claim 18 is a method claim, and is rejected for the same reasoning as that of claim 9.

Allowable Subject Matter

Claims 3 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or Faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to:

Crystal Park II
2121 Crystal Drive
Arlington, VA 22202 Sixth Floor (Receptionist).

TJL

MARK WALLERSON
PRIMARY EXAMINER